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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/631,358	07/30/2003	David John Kucera	PC19184/AG0184-US	3459
28940	7590	11/23/2005	EXAMINER	
AGOURON PHARMACEUTICALS, INC. 10777 SCIENCE CENTER DRIVE SAN DIEGO, CA 92121			HOFFMAN, LEXINGTON A	
			ART UNIT	PAPER NUMBER

1625

DATE MAILED: 11/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/631,358

Applicant(s)

KUCERA ET AL.

Examiner

Lexington A. Hoffman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-33 is/are allowed.
- 6) ☒ Claim(s) 34-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>8/29/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-43 are pending in this application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 34 is rejected under 35 U.S.C. 102(b) as being anticipated by Sosnovskikh, et al., in accession number 2000:17437 HCAPLUS (see attached STN results). The compound of formula I is anticipated where R1 is CF₃, and R2 and R3 are both H.

Claim 34 is rejected under 35 USC 102(b) as being anticipated by Sasaki, et al., accession number 1997:122435 HCAPLUS, see attached STN results). The compound of formula I is anticipated where R1-R3 are all H.

Claim 34 is rejected under 35 USC 102(b) as being anticipated by Osowaka-Pacewicka, et al., accession number 1990:551764 HCAPLUS. The compound of formula I is anticipated where R1 is n-propyl and n-butyl, and R2 and R3 are both H.

Claim 34 is rejected under 35 USC 102(b) as being anticipated by Stapleton, accession number 1985:541408 HCAPLUS. The compound of formula I is anticipated where R1 and R2 are both H, and R3 is an amine-substituted heteroalkyl (prior art compounds have alkyl chains with 2, 4, and 6 carbons, with 1, 2, and 3, amine

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substitutions, respectively--see attached STN results). Alternatively, R3 could be H and R2 the heteroalkyl.

Claims 34-38 are rejected under 35 USC 102(b) as being anticipated by Grudzinski, et al., Accession number 1977:170767 HCAPLUS (see attached STN results). The compound of formula I is anticipated where R1-R3 is methyl.

Claim 34 is rejected under 35 USC 102(b) as being anticipated by Gipson, in USPAT 3872116. The compound of formula I is anticipated where R1 is H, R2 is H, and R3 is CH₂OH (formula IV in column 2, definition of R3 and R4 column 1, lines 30-45). Alternatively, R3 could be H and R2 CH₂OH.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 39-43 are rejected under 35 USC 102(e) as being anticipated by Chu, et al., USPAT 6720346. The compound of formula VII is anticipated where R4 and R5 are H, X is C, and R6 and R7 are F (column 25, compound 2).

Oath/Declaration

A new oath or declaration is required because no date is listed for Kucera's signature. Appropriate correction is required.

Information Disclosure Statement

Page 3 of the IDS lists Still, et al., "Rapid Chromatographic Technique for Preparative Separations with Moderate Resolution", but a copy of this reference is not found in the file.

Allowable Subject Matter

Claims 1-33 are allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lexington A. Hoffman whose telephone number is 571-272-4328. The examiner can normally be reached on Monday-Friday 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecelia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Lexington Hoffman

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A handwritten signature in black ink, appearing to read 'Cecilia Tsang', with a stylized flourish at the end.

Supervisory Patent Examiner

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